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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

TERM.

No. 928

CUTLER MAIL CHUTE COMPANY,
Petitioner, Plaintiff and Appellee below,

against

CAPITOL MAIL CHUTE CORPORATION,
Respondent, Defendant and Appellant below.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

C. P. GOEPEL,
165 Broadway,
New York, N. Y.,
for Petitioner.

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IN THE

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TERM.

CUTLER MAIL CHUTE COMPANY, Petitioner, Plaintiff and Appellee below, against CAPITOL MAIL CHUTE CORPORATION, Respondent, Defendant and Appellant below.	No.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

TO THE HONORABLE THE CHIEF JUSTICE OF THE UNITED STATES AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your Petitioner, Cutler Mail Chute Company, prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Second Circuit to review a judgment of that Court (entered March 10, 1941) in the above entitled cause as to a decision of the Court of Appeals of the Second Circuit, reversing the judgment of the U. S. District Court of the Eastern District of New York.

Summary Statement of the Matter Involved.

This is a patent infringement suit filed, April 28, 1939, and tried and decided subsequent to the adoption of the new Rules of Civil Procedure.

The District Court held all of the claims of the patent to be valid and infringed on February 5, 1940. (31 F. Supp. 954 and herein, Tr. pp. 216-239.)

Findings of Fact were then submitted, and having been approved by the Court, were entered on March 5, 1940 (Tr. pp. 240-259). No motion to amend these Findings of Fact, or to make additional Findings, was made by the Defendant under Rule 52 (b), whereupon the original Findings form the basis for the judgment (Tr. p. 260) entered upon the same. Nor were the Findings excepted to by the Defendant at any time.

The Court of Appeals did not hold that any of these Findings of Fact were "clearly erroneous". It reversed the judgment on March 10, 1941, without reference to the findings of the District Court.

The filing date of this petition is ~~March 31~~ April 7, 1941.

This Court Has Jurisdiction to Review the Judgment in Question.

I.

There were no concurrent findings by the Courts below. (*Altoona Pub. Theatres* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477.)

II.

There is no possibility of obtaining a conflicting decision in a Court of another appellate jurisdiction. (*Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 49.)

III.

There is jurisdiction by this Court under Section 240a of the Judicial Code, 28 U. S. C. 347 as amended.

Questions Presented:

1.

Are Findings of Fact of the District Court under R. C. P. 52 to be treated by the Court of Appeals in an equity case as unassailable unless "clearly erroneous"?

2.

Is a prior art patent to be taken *as it is,* or may it be reconstructed by a court in the light of the teachings of the patent in suit and then used to defeat the patent in suit?

3.

Does a combination of old elements to be a combination in point of law require that a new result be produced by the co-action of such elements, or is it sufficient for validity that such elements co-acting together produce an old result in a more "facile, economical and efficient manner?"

Reasons for Granting the Writ.

1.

There should have been a concurrence by the Court of Appeals in the Findings of Fact of the District Court since unless held "clearly erroneous", they are unassailable under the new Rules of Civil Procedure (Rule 52).

2.

There was a reconstruction of the earlier prior art patent by the Court of Appeals in the light of the patent in suit, upon which reconstructed device, the conclusion of invalidity followed. In so reconstructing the prior art not designed nor intended for the same pur-

pose, it decided the case in conflict with applicable decisions of this Court. The District Court, however, considered the prior patent *as it is, i. e.,* unchanged, and found that the prior patent had nothing to do with the invention set forth in the claims in suit, and in so doing followed the applicable decisions.

3.

There was a failure by the Court of Appeals to apply the law of combinations to the claims in suit, which are distinctly combination claims. The District Court, however, did apply the law of combinations and found that the claimed combinations were not present in the prior art.

There are many cases of this Court declaring what a combination *is not.* There is confusion in the Courts of Appeals (Seventh and Eighth) as to what is required to sustain a combination. The Second Circuit is none too clear at present. The case at bar sharply embodies this important point in patent law and is peculiarly fitted to enable this Court to clarify and set at rest the confusion which now exists.

4.

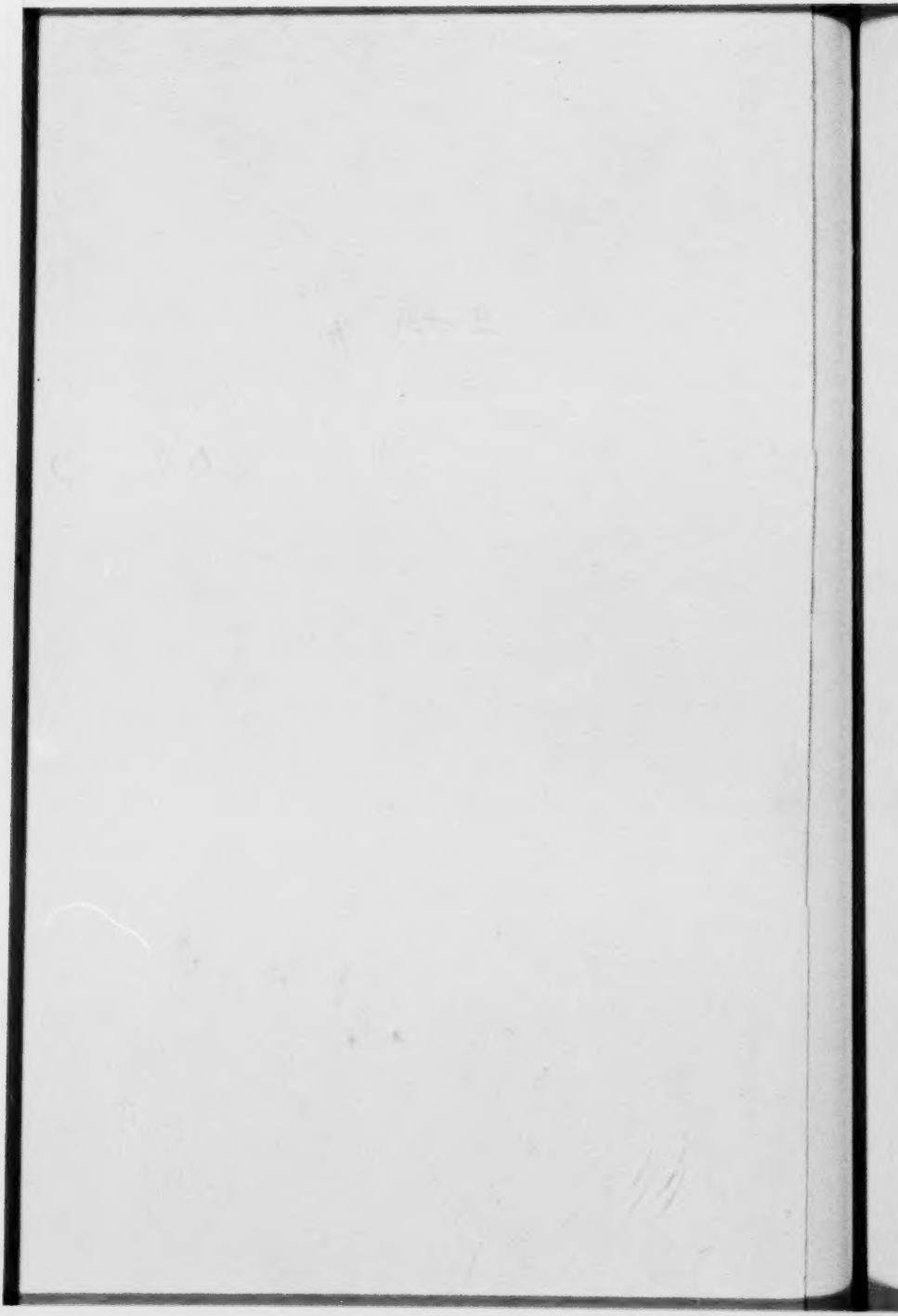
The principles at issue are of national importance, and the judgment of the Court of Appeals is probably in conflict with the applicable decisions of this Court.

WHEREFORE, your petitioner prays that a writ of Certiorari to the United States Circuit Court of Appeals of the Second Circuit be granted.

March 25, 1941.

CUTLER MAIL CHUTE COMPANY,

By G. A. BRIDGMAN,
President.



IN THE

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BRIEF IN SUPPORT OF PETITION.

In Support of Jurisdiction.

I.

There were no concurrent findings by the courts below as to the claims in issue.

The District Court considered in its opinion *all* of the claims in suit, namely nine claims (Tr. pp. 221 to 223), and these were reproduced in the Findings of Fact (Tr. pp. 243 to 246).

But the Court of Appeals apparently only considered claim 2, since it stated: "It will suffice to quote claim two which reads as follows:

> 2. The combination with a mail chute having
> a mail receiving aperture and
> a passage leading therefrom to the interior of the chute and with

a delivery aperture below the first named aperture adapted to discharge exteriorly of the chute, there being communication between said passage and the discharge aperture, of

a weighing device operating in the passage to normally direct light foreign matter deposited in the mailing aperture to the delivery aperture but adapted to be displaced by mail matter and permit its passage to the chute."

However, other claims embrace a different structure, as is evident from claim 8, as an example:

"8. The combination with a mail chute having

a mail receiving aperture leading to the interior of the chute and

a delivery aperture below the same adapted to discharge exteriorily of the chute, of

a device arranged between the two apertures adapted to block access (see 18 in Figure 4, and 24 on Figure 8, in the patent in suit Tr. pp. 74-75) of usual mail matter inserted through the upper receiving aperture from passage to the lower discharge aperture while permitting passage of small objects, such as litter similarly introduced to and through the discharge aperture."

The decision of the lower court is based upon *all* of the claims in issue. The decision of the Court of Appeals refers only to claim 2 and it grounded its conclusion upon elements forming only part of a single claim in suit. There were no concurrent Findings by the Courts below as to the claims in issue. The applicable principle is stated

in the case of *Altoona Pub. Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477:

> "While both courts below have found invention and sustained the patent, the Court of Appeals as will presently appear in more detail, *did not pass on the separate claims in issue,* but found invention in a combination of elements not embraced in any single claim. In consequence, *the case presents no question of concurrent findings by the courts below* that the claims in issue severally involve invention." (Italics supplied.)

II.

There is no possibility of obtaining a conflicting decision in a court of another appellate jurisdiction.

All of Petitioner's competitors have respected the patent in suit since its issuance on May 9, 1933, save this defendant, and no installation save the one sued on in this case has been made by this defendant. Petitioner has no one to sue in any other Judicial Circuit in the hope of bringing about a conflict of decisions. It is confronted with the immediate necessity of filing a disclaimer. (*Ensten* v. *Simon A. Co.*, 282 U. S. 45; *Altoona Pub. Theatres* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477; *Triplett* v. *Lowell*, 297 U. S. 638.)

Only the Defendant made the accused structures in this case, and mainly by hand, and installed them only in one building and made no offer of any such structures to any one else in the trade. The present economic conditions have suspended or limited the requirement of mail chutes with this patented device therein. In consequence, as no one else is making or selling in another judicial

circuit a structure such as to be an infringement, there is no possibility of obtaining a conflict of decisions in another appellate court.

Petitioner appears to be in exactly the same position as the plaintiff in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 49. In that case it was said:

> "Litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

Unless this court grants relief, all of the present claims in suit of plaintiff's patent will have to be disclaimed, thus rendering the patent in suit a nullity, although all the *claims* have not been held specifically invalid by the Court of Appeals.

III.

Section 240a (U. S. C. 28, sec. 347) provides:

> "In any case civil or criminal, in a Circuit Court of Appeals, or in the U. S. Court of Appeals for the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the case had been brought there by unrestricted appeal."

In Support of the Reasons.

1.

The findings of fact should have been considered as unassailable under R. C. P. 52.

The pertintent Findings of Fact of the District Court as to the Teevan Patent not referred to by the Court of Appeals, read as follows:

> "The principal object of the invention (of the prior Teevan Patent) was to prevent the surreptitious extraction of the contents of the box. (Tr. p. 248) * * * but that is in no sense the type of trap of the patent in suit. (Tr. p. 248) * * * The letter flap of Teevan does not intercept, divert and discharge away from the 'letter passage', the litter injected into a mail chute. It was not intended to work that way, and as shown cannot work that way. (Tr. p. 249) * * * The Teevan Patent * * * did not teach the use of the letter flap to intercept, divert, and discharge away from the 'letter passage' the litter injected into a mail chute." (Tr. p. 250.)

Unless these were shown to be "clearly erroneous", these should have been accepted as premises by the Court of Appeals.

> "* * * that findings must be sustained if there is any 'substantial evidence' to support them. Rule 52a of the Federal Rules of Civil Procedure provides:
>
> > 'Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the

credibility of the witnesses'." *Anglo-California Nat. Bank* v. *Lazard,* 106 F. (2), 693, 706 (C. C. A. 9).

"The provisions of the new procedural rules that the Findings of Fact of the trial judges are to be accepted on appeal unless clearly wrong is but a rule long recognized and applied by Courts of Equity." *Guilford Const. Co., et al.* v. *Biggs,* 102 F. (2), 46 47 (C. C. A. 4).

"While it is true that on an appeal in equity a case is to be examined on both the law and the facts, and the reviewing court is not bound by the trial judge's Findings of Fact, it is equally true that the Appellate Court ought not to disturb such findings especially where the evidence is conflicting and the credibility of witnesses is involved, unless it appears that the trial judge was clearly wrong." *Malloy* v. *New York Life Insurance Co.,* 103 F. (2) 439 (C. C. A. 1).

"So far as the findings of the master or Judge who saw the witnesses depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable." *Adamson* v. *Gilliland,* 242 U. S. 350.

Also: *U. S.* v. *Esnault-Pelterie,* ~~229~~ 299 U. S. 201; 303 U. S. 26.

2.

***Ex post facto* wisdom obtained from a patent cannot be used to reconstruct a prior art structure.**

The District Court considered the prior art as it is in accordance with settled law:

> "When it is sought to ascertain the state of the art by means of prior patents, nothing can be used except what is disclosed on the face of these patents." (*Naylor* v. *Aslop Process Co.* 168 Fed. 911, at 920 C. C. A. 8.)

But the Court of Appeals reconstructed the prior art Teevan patent in the light of the teachings of the patent in suit. The claims in issue are always the keystone from which the reasoning in every patent suit must begin. Instead, the Court of Appeals having in mind the patentee's solution of the problem, applied this to the forty year old still-born patent to Teevan, without recalling that "nothing is easier in patent litigation than to confuse a trifling physical change with the ingenuity demanded for its discovery." (*The Refractolite Corporation, et al.* v. *Prismo Holding Corporation, et al.*, C. C. A. 2, decided February 24, 1941, unreported). When the Court of Appeals stated: "To space more widely apart the two lowest bars of the grid and to slant the hinged flap C so that it would divert the trash into the opening rather than serve as a shelf upon which it could gather * * *", it reconstructed the old Teevan patent in the light of the patent in suit and in doing this, admitted, in effect, that the Teevan patent as it is did not anticipate (Tr. p. 279).

The Court of Appeals furthermore used neither the Findings of Fact, nor the claims in suit, as premises,

for its reasoning to define the invention in issue but set up a structure which it thought the patent in suit was, when it said that: "Van Riper's claim to invention must rest upon the mechanical changes which should be required to adapt the Teevan structure for use in a mail chute," (Opinion of C. C. A. Tr. p. 279).

The principle thereby established, will enable any defendant in a patent suit to assert, that the trier of facts can now reconstruct a prior art structure in the light of the knowledge obtained from the patent in suit then under consideration. No patent can remain valid under such conditions.

3.

The claims in suit are distinct combination claims and the Court of Appeals should have applied the law applicable thereto as did the District Court.

A combination of old mechanical parts is valid if it produces a new result, such new result of the conjoint action of the parts setting into being a new energy. A combination in point of law is valid if its entirety, in distinction to its parts, is not found as an entirety in the prior art, and is infringed, if that entirety is found in the accused structure.

In the Findings of Fact which have not been disturbed by the Court of Appeals, it appears:

> "While it is true that some of the elements of the combination of the claims of the patent in suit are old, and some old elements are found both in the Teevan Patent and in the patent in suit, the combinations in the patent in suit and in the Teevan Patent are different, function differently, and the combinations of the patent in suit produce a new and useful result over the Teevan patent structure." • • •

> "By the law of structure of the Teevan patent is presented a co-action of parts totally different from the co-operative law of the patent in suit. Defendant praises the Teevan patent, and compliments the patent in suit by imitation." (Tr. p. 249.)

All of the claims in suit are "combination" claims.

A combination claim is valid unless anticipated by the same entirety or combination. (*Parkes* v. *Booth,* 102 U. S. 96, 104.) This rule requires a comparison of the claims of the patent in suit with the alleged prior art, not in regards to the elements composing the combination, but in regards to the co-operative law or entirety set into being or created by the patented combination. (*Seymour* v. *Osborne,* 11 Wall. 516; *Curtis on Patents,* p. 118, Sec. 111a, fourth edition.)

Under this rule the District Court properly held, as shown in the above quoted Findings of Fact, that the Teevan patent did not anticipate because it did not present the same entirety or co-operative law.

The Court of Appeals disregarded this rule. Any future defendant in a patent case can now contend in the Second Circuit that the Court of Appeals having quoted the combination claim, it is sufficient to find only *some* of the elements in the prior device and not all of the elements in the combination, thus in conflict with the law of this Court. (*Parkes* v. *Booth,* 102 U. S. 96, 104.)

There are cases of this court stating what a combination is not, such as *Hailes* v. *Van Wormer,* 20 Wall. 353, *Reckendorfer* v. *Faber,* 92 U. S. 347 and *Pickering* v. *McCullough,* 104 U. S. 310.

There is today a sharp conflict as to the law of combinations. Certain decisions hold that a combination to be valid must produce "a new result"; there are other cases holding that a combination may be valid if it produces an old result "in a more facile, economical and efficient manner."

Typical of the foregoing "novel result" cases are the following: *Seymour* v. *Osborne,* 11 Wall. 516; *Gould* v. *Rees,* 15 Wall. 187; *Fuller* v. *Yentzer,* 94 U. S. 288, 297; *Palmer* v. *Corning,* 156 U. S. 342; *Leeds & Catlin Co.* v. *Victor Talking Machine Co.,* 213 U. S. 301; *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.,* 220 U. S. 428. These cases support the view of Judge Evans of the Seventh Circuit in *Hartman F. & C. Co.* v. *Banning* (C. C. A. 7) 59 F. (2) 29, which required a new result.

Cases of an old result "in a more facile, economical and efficient manner" are all those of Judge Sanborn who initiated this doctrine in the Eighth Circuit: *National Hollow B. B. Co.* v. *Interchangeable B. B. Co.,* 106 Fed. 693, 707 (C. C. A. 8); *Kinloch Telephone Co.* v. *Western Elec. Co.,* 113 Fed. 659, 665 (C. C. A. 8); *Ide* v. *Trorlicht, Duncker & Renard Carpet Co.,* 115 Fed. 137, 141 (C. C. A. 8); *Anderson* v. *Collins,* 122 Fed. 451, 459 (C. C. A. 8); *Ottumwa Box Car Loading Co.* v. *Christy Box Car Loading Co.,* 215 Fed. 362, 369 (C. C. A. 8); *New York Scaffolding Co.* v. *Whitney,* 224 Fed. 452, 456 (C. C. A. 8); *Minneapolis, St. Paul & S. S. M. Ry. Co.* v. *Barnett & Rec. Co.,* 257 Fed. 302, 307 (C. C. A. 8).

In this last named case, and in some of the others of Judge Sanborn, *Seymour* v. *Osborne,* 11 Wall. 516 and *Rees* v. *Gould,* 15 Wall. 187, are relied upon to support this doctrine, but Mr. Justice Clifford carefully refrained from so expressing himself. In *Galvin Mfg. Co.* v. *Emerson,* 19 F. (2) 885, 890 (C. C. A. 8), Judge Phillips followed this rule of "more facile, economical and efficient manner" and then sitting in the Tenth Circuit again followed it in *Stearns Roger Mfg. Co.* v. *Ruth,* 62 F. (2) 442, 446 (C. C. A. 10). In *General Electric Co.* v. *Maytag,* 100 F. (2) 218, 221, Judge Gardner of the Eighth Circuit followed it. It will be noted that this doctrine prevails in the Eighth Circuit, and though questioned by Judge Evans in the Seventh Circuit as before shown, it is now

being applied therein, as recently as in *Safway Scaffolding Co.* v. *Patent Scaffolding Co.*, 110 F. (2) 1008. (Certiorari denied.)

The cases of Judge Sparks of the Seventh Circuit citing *N. Y. Scaffolding Co.* v. *Whitney*, 224 Fed. 452 (C. C. A. 8), in support of an old result in a more facile, etc., manner, are *Young Radiator Co.* v. *Modine Mfg. Co.*, 55 F. (2) 545 (C. C. A. 7); *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. (2) 904 (C. C. A. 7); and *Safway Steel Scaffolding Co.* v. *The Patent Scaffolding Co.*, 110 F. (2) 1008 (C. C. A. 7).

In the *Iron Fireman* case, 89 F. (2) 904, as showing the conflict, Judge Sparks said, Judge Evans also sitting:

> "We do not regard this holding as inconsistent with that of *Hartman F. & C. Co.* v. *Banning*, for in that case there was neither a new result nor *an old one performed more efficiently.*" (Italics supplied.)

In the case at bar, each claim is denominated as a combination. The Court of Appeals should have made these combination claims the keystone premise of the entire case, and should have also decided the case on combination law principles as was done by the District Court. (For a sharp application of combination law, see *Westinghouse Elec. & Mfg. Co.* v. *Cutter Elec. & Mfg. Co.*, 143 Fed. 966 [C. C. A. 3]; *Westinghouse Elect. & Mfg. Co.* v. *Condit Elec. Mfg. Co.*, 167 Fed. 546 [C. C. A. 2]; *Westinghouse Elec. & Mfg. Co.* v. *Cutter Elec. & Mfg. Co.*, 169 Fed. 634 [C. C. A. 3]; and *Fuller* v. *Yentzer*, 94 U. S. 288, 297.)

The present situation in the Second Circuit is none too clear as appears from the following excerpt, which might have been quoted in full, but for brevity is only indicated. It is submitted that there is confusion between what a combination is, and whether it is patentable:

> "We have not dealt with the defendant's argument that the first patent is for an 'aggregation.' Frankly, we are unable to attach a definite meaning to that word. * * * Therefore, we can find little advantage in a discussion of what is or what is not an 'aggregation.' * * * We had best abandon it." *Sacks* v. *Hartford Elec. Supply Co.*, 47 F. (2) 743, 748 (C. C. A. 2).

As an aggregation is the opposite to a true combination, the definition of aggregation assists in determining the meaning of combination. See *Hailes* v. *Van Wormer*, 20 Wall. 353. Is an "old result in a more facile, economical or efficient manner," an aggregation or a combination?

4.

The national importance of the law of combinations to industry should induce this court to set this conflict as to what a true combination is at rest.

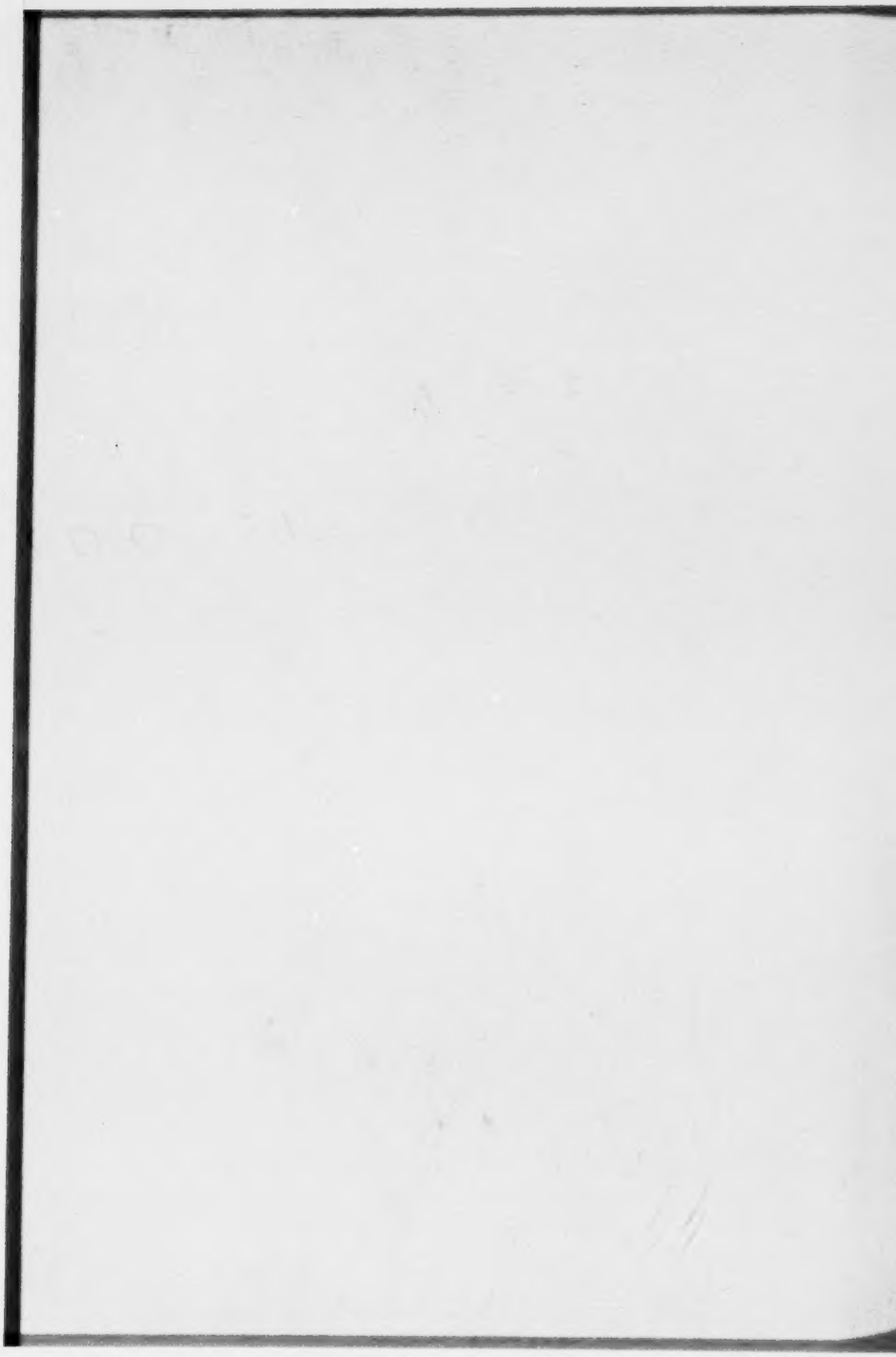
The time consuming and painstaking preparation of Findings under R. C. P. 52, is rendered useless if the findings are not considered by the Appellate Court.

The doctrine of reconstructing or reorganizing a prior patent not designed nor intended for that purpose in the light of the teachings of the patent in suit, if made permanent, would undermine the Patent Act.

Respectfully submitted,

C. P. Goepel.

New York, March 31, 1941.



Supreme Court, U.S.
FILED
MAY 15 1941
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM

No. 928

CUTLER MAIL CHUTE COMPANY,

Petitioner, Plaintiff
and Appellee below

—against—

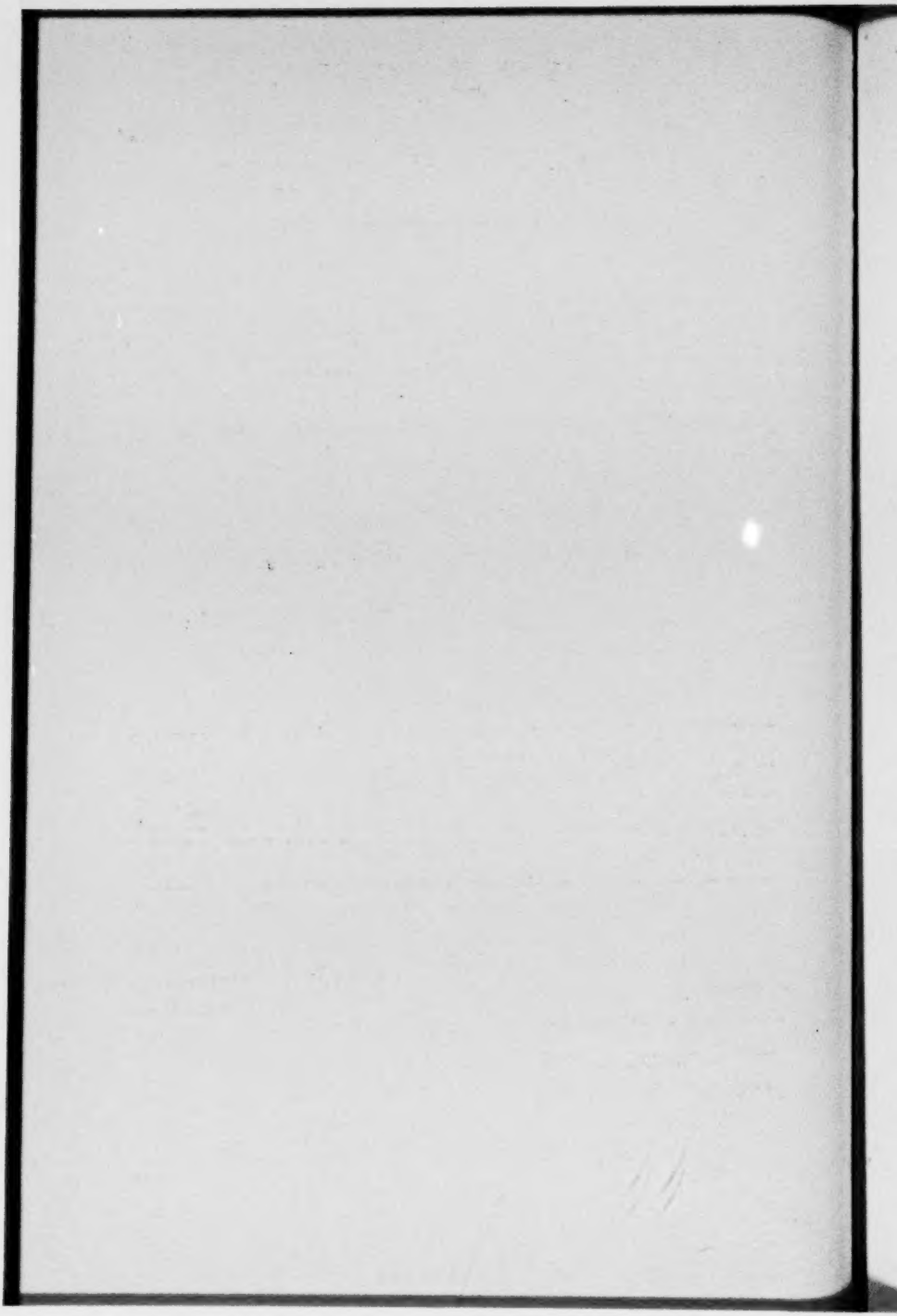
CAPITOL MAIL CHUTE CORPORATION,

Respondent, Defendant
and Appellant below.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

ROBERT I. DENNISON,
for Respondent.

PERCY FREEMAN,
MAXWELL E. SPARROW,
Counsel.



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Supreme Court of the United States

OCTOBER TERM

No. 928

CUTLER MAIL CHUTE COMPANY,

Petitioner, Plaintiff
and Appellee below

—against—

CAPITOL MAIL CHUTE CORPORATION,

Respondent, Defendant
and Appellant below.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

Statement.

This brief is directed in reply to petitioner's brief in support of its petition for writ of certiorari.

In its "Summary Statement of the Matter Involved", petitioner states that no motion to amend the Findings of Fact, or to make additional Findings, was made by the Defendant (Respondent here). Rule 52(b) of the Rules of Civil Procedure states in part as follows:

> "When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question

has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment."

In arriving at its decision the Court of Appeals must have held that those Findings of Fact and Conclusion of Law and the decision upon which the decree was founded, were "clearly erroneous", otherwise the Court of Appeals would not have reversed the decree.

In Answer to Petitioner's Contention in Support of Jurisdiction.

Petitioner, in urging that this Court has jurisdiction to review the judgment in question, presents three points, namely, (I) that there were no concurrent findings by the courts below; (II) that there is no possibility of obtaining a conflicting decision in a Court of another appellate jurisdiction; (III) that there is jurisdiction by this Court under Section 240a of the Judicial Code (p. 2 of Pet. and Br.).

In support of point (I) (p. 5 of Pet. and Br.) petitioner contends that since the District Court had considered all of the claims of the patent in suit, the Circuit Court of Appeals should have done likewise. Respondent submits that the Court of Appeals was correct in considering claim 2 only of the patent in suit because this combination claim brings out and includes all of the essential elements of the alleged invention and consequently if this claim falls the other claims, must *ipso facto* fall, the other claims being mere variations of this claim or broader than this claim. The other claims do not embrace a different structure. In claim 8, given as an example by the Petitioner, the *device arranged between the two apertures adapted to block access* of usual mail matter inserted through the upper receiving aperture from passage to the lower discharge aperture while permitting passage of small objects, such as. litter simi-

larly introduced to and through the discharge aperture" is expressed and finds its equivalent in claim 2 in *a weighing device* operating in the passage to normally direct light foreign matter deposited in the mailing aperture to the delivery aperture but adapted to be displaced by mail matter and permit its passage to the chute."

Therefore, Petitioner's statement that there were no concurrent Findings by the Courts below as to the claims in issue, is erroneous.

Petitioner relies upon the case of *Altoona Pub. Theatres* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477. In that case this Court stated:

> "The Court of Appeals in upholding the patent, made no examination of its separate claims, but treated the patent as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, *although nowhere in the patent is any such combination claimed.* The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention."

That is what led this Court to the conclusion that:

> "While both courts below have found invention and sustained the patent, the Court of Appeals as will presently appear in more detail, did not pass on the separate claims in issue, but found invention in a combination of elements not embraced in any single claim. In consequence, the case presents no question of concurrent findings by the courts below that the claims in issue severally involve invention."

If there were invention in the case at bar, it would be found in a combination of elements embraced in any single claim.

It might be mentioned here in passing, that this Court in the *Altoona* v. *Am. Tri-Ergon* case stated that:

> "An improvement to an apparatus or method to be patentable, must be the result of invention, and not the mere exercise of the skill of the calling or an advance plainly indicated by the prior art. *Electric Cable Joint Co.* v. *Brooklyn Edison Co.*, 292 U. S. 69, 79, 80."

The Circuit Court of Appeals followed this Court in ruling that

> "Since Van Riper is chargeable with knowledge of everything disclosed by the Teevan patent and the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of a mail collecting receptacle, Van Riper's claim to invention must rest upon the mechanical changes which would be required to adapt the Teevan structure for use in a mail chute. Obviously Teevan's chute would have to be compressed and turned from a nearly horizontal position to one nearly vertical. It is urged that if that were done the trash would gather at the bottom of the chute against the flap C; and so it would if the edge of the flap rested on a bottom bar of the chute and enough below the last slot of the grid to form a shelf upon which the trash could rest. But the merest tyro should be able to see that the more nearly vertical the chute, the more open it could and should be. Teevan had the bars of his grid rather close together because it was nearly horizontal and the letters must be as sure to pass over the openings as the trash must be to drop through them. To space more widely apart the two lowest bars of the grid and to slant the hinged flap C so that it would divert the trash into the opening rather than serve as a shelf upon which it could gather, were adaptations that would shriek to be made to one who

was trying to solve Van Riper's problem with Teevan's structure before him. *We are of opinion that the appellant is right in urging that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit.*

With respect to Petitioner's point (II) (p. 7 of Pet. and Br.) in support of jurisdiction, the competitive field in the art to which the patent in suit pertains is indeed very narrow, there being relatively few manufacturers of mail chutes. Consequently, any lack of copying of the patented structure, is due to the scarcity of competitors rather than respect for the patent. Indeed, the Petitioner may have answered the cause for the so-called respect for the patent by its own statement, namely:

> "The present economic conditions have suspended or limited the requirement of mail chutes with this patented device therein. In consequence, as no one else is making or selling in another judicial circuit a structure such as to be an infringement * * * " (pp. 7, 8 of Pet.).

The mail chute business is not concentrated in the second circuit, hence Petitioner is not in the same position as the plaintiff in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 49.

With regard to petitioner's point (III) (p. 8 of Pet. and Br.), subdivision 5 of Rule 38 of the Rules of this Court specifically sets out the Grounds for Granting Review by Certiorari.

> "A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor."

There is no situation in the case at bar which falls within the character of reasons which ought to be considered by this court. There is no conflict of decisions between two circuit court of appeals; there is no important question of general law in a way probably untenable or in conflict with the weight of authority or a federal question in conflict with applicable decisions of this court which was decided by the Circuit Court of Appeals, but only questions which are well founded in patent law.

The power of The Supreme Court to send a writ of certiorari to the Circuit Court of Appeals is exercised by it only in cases of great importance; or in cases of conflict between two or more Circuit Court of Appeals, or between such a court and a state court; or in cases which effect some interest of this nature. (*Forsyth* v. *Hammond,* 166 U. S. 506, 514, 41 L. Ed. 1095). And it is only when the lower courts are distinctly wrong that they will be reversed on questions of fact. (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 52 L. Ed. 1122). *See Walker on Patents, Deller's Edition* (1937) Vol. 3, pp. 1945, 1946.

Regarding Petitioner's Reasons for Granting Writ (pp. 3, 4 of Pet. & Br.)

In Answer to Petitioner's Argument Appearing Under 1, on Page 9 of its Petition and Brief.

Petitioner states that the findings of fact should have been considered as unassailable under R. C. P. 52. The primary purpose of rule 52 of the Rules of Civil Procedure that in all actions tried upon facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon is intended to aid the reviewing court by affording a clear understanding of the basis of the decision of the trial court. *Tulsa City Lines* v. *Mains,* C.

C. A. Okl. 1939, 107 F. 2d 377. The findings of fact of the District Court in the case at bar did serve such purpose for the Circuit Court of Appeals, but the latter court saw fit to reverse the findings of the lower court, as by its decision it deemed the same clearly erroneous. In *Malloy* v. *New York Life Insurance Co.,* 103 F. (2) 439 (C. C. A. 1) cited by Petitioner, the court stated that "reviewing court is not bound by the trial judge's Findings of Fact." In that case the Court stated that where the credibility of witnesses was a determinative factor in arriving at findings of fact, the reviewing court will not usually upset those findings in view of the opportunity of the trial judge to see and hear witness testify. In the case at bar the prior art was sufficient to invalidate the claims of the patent and a reference to the opinion of the Circuit Court of Appeals will clearly show that that court based its decision of reversal on its construction of the documentary prior art.

The Circuit Court of Appeals is not required to take facts as found by the district judge, but must determine legal effect of facts as presented by the record, on appeal from the judgment. *U. S.* v. *South Georgia Ry. Co.,* C. C. A. Ga. 1939, 107 F. 2d 3; *U. S.* v. *Mitchell,* C. C. A. Mo. 1939, 104 F. 2d 343; *Cherry-Burrell Co.* v. *Thatcher,* C. C. A. Mont. 1939, 107 F. 2d 65.

Petitioner contends that the Circuit Court of Appeals did not refer to "pertinent Findings of Fact of the District Court as to the Teevan Patent" set out on page 9 of its Petition and Brief. Petitioner is clearly in error in its contention. The Circuit Court of Appeals in its opinion (R., p. 278; F. 833) in referring to defendant's (respondent's) contention that plaintiff's (petitioner's) idea of an apparatus which accepts mail and rejects refuse is old in the art, stated:

> "But its chief reliance is on the Teevan patent. This is a patent for a "letter box", which is analagous art

> and is classified by the Patent Office in the same class as mail chutes, namely, class 232 'Deposit and Collection Receptacles.' 'The patent states that the invention relates to improvements in letter boxes and is designed 'to prevent the contents being injured by the introduction of lighted matches, burning cigars or cigarettes, and such like.' Thus the conception of separating mail from trash and preventing the latter from getting into the collection receptacle long antedated the patent in suit and the means adopted by Teevan to accomplish this purpose are strikingly similar to those adopted by Van Riper more than 30 years later."

The court then goes at length into the construction of the Teevan patent and its application to the alleged invention of the patent in suit. In the face of the opinion of the Circuit Court of Appeals, how in the name of common sense, can the petitioner contend that the Circuit Court of Appeals did not refer to the pertinent Findings of Fact of the District Court as to the Teevan patent. A comparison of the facts set out in the opinion of the Circuit Court of Appeals with the Findings of Fact of the District Court is convincing that the latter were shown to be "clearly erroneous" and the Circuit Court of Appeals was correct in not accepting these as premises.

In Answer to Petitioner's Argument Appearing Under 2, on Page 11 of its Petition and Brief.

Petitioner argues that the Circuit Court of Appeals used *ex post facto* wisdom from the patent in suit to reconstruct a prior structure; that the Appellate Court reconstructed the Teevan patent in the light of the teachings of the patent in suit. Nothing is further from the truth. The Circuit Court of Appeals considered the prior art *as it is* and applied it to the patent in suit in the light of the knowledge chargeable to Van Riper, the patentee and of ordinary mechanical skill required for conversion.

"Since Van Riper is chargeable with knowledge of everything disclosed by the Teevan patent and the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of a mail chute collecting receptacle, Van Riper's claim to invention must rest upon the mechanical changes which would be required to adapt the Teevan structure for use in a mail chute." (R., p. 279; F. 835.)

"We are of opinion that the appellant is right in urging that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit." (R., p. 279; F. 837.)

Answering Petitioner's Argument Appearing Under 3, on Page 12 of its Petition and Brief.

The combination of old mechanical parts in the patent in suit did not produce any new result. Petitioner's combination in its entirety is found as an entirety in the prior art. The Circuit Court of Appeals in no mistakeable terms so decided. That Appellate Court without doubt did disturb the subject matter (in the Findings of Fact) set out at pages 12 and 13 of Petitioner's Brief. That the combinations in the patent in suit and in the Teevan Patent are *not* patentably different; that they do not function differently; that the combinations of the patent in suit do *not* produce a new and useful result over the Teevan patent structure; and that the law of structure of the Teevan patent does *not* present a coaction of parts totally different from the cooperative law of the patent in suit, may be gleaned from the upper courts decision. Thus, the upper court ruled that the subject matter in the lower court's findings is "clearly erroneous".

Petitioner opines that a combination claim is valid unless anticipated by the same entirety or combination and that this rule requires a comparison of the claims of the patent

in suit with the alleged prior art in regards to the so-called cooperative law or entirety set into being by the patented combination. The Circuit Court of Appeals in its opinion made the comparison. In referring to the Teevan structure it stated:

> "Within the letter-box is a chute A having its upper open end coinciding with the letter-slot. At the other end of the chute is hinged a weighted flap C so balanced that a descending letter will cause it to open and allow the letter to fall into the box. The bottom side D of the chute is provided with a number of slots of sufficient width to allow matches, cigarettes and such like to drop through this grid into a receptacle E fixed beneath the chute."

The Circuit Court of Appeals properly held that the Teevan patent did anticipate the patent in suit and that it did present the same entirety. There is no conflict between the holding by the Circuit Court of Appeals and the law of this Court, for the Appeals Court found the combination claim anticipated by the Teevan patent which shows the same entirety or combination as the patent in suit and only requires the application of ordinary mechanical skill for the slight change-over.

There is no conflict in the courts as to the subject matter presented by petitioner for consideration by this court. The patentee of the patent in suit neither invented a combination of elements which produced a new result nor produced an old result "in a more facile, economical and efficient manner". The Court of Appeals for the Second Circuit so decided and reversed the decree of the District Court.

Borrowing from petitioner's brief (p. 15) the citation *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. (2d) 90 (C. C. A. 7) and restating the exact excerpt taken therefrom by petitioner.

"We do not regard this holding as inconsistent with that of *Hartman F. & C. Co.* v. *Barring,** for in that case there was *neither a new result nor an old one performed more efficiently.*"

This court has repeatedly held a patent invalid because the combination of elements neither produced a new result nor produced an old result in such a way as to rise to the dignity of invention. *Wright* v. *Yuengling,* 155 U. S. 47, 53; *Stimpson* v. *Woodman,* 10 Wall. 117; *Smith* v. *Nichols,* 21 Wall. 112; *Guidet* v. *Brooklyn,* 105 U. S. 550; *Hall* v. *Macneale,* 107 U. S. 90.

Petitioner asks this Court to grant the writ because it contends that there is a sharp conflict as to the law of combinations. This was not involved in the decision of the Circuit Court of Appeals. That Appellate Court ruled that the patentee is chargeable with knowledge of everything disclosed by the Teevan patent; that the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of the mail collecting receptacle; and that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit. The Appellate Court followed the decision of this Court in *Samac Automatic Machine Corp.* v. *Wirebounds Patents Company et al.,* 282 U. S. 704, where at page 713, Mr. Justice Stone stated for the Court:

"Their adaptation to the new use was not the creative work of the inventive faculty. It was "but the display of the expected skill of the calling, and involves only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice." *Hollister* v. *Benedict*

* (C. C. A. 7) 59 F. (2) 29).

Mfg. Co., 113 U. S. 59, 72, 73; *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177; *Aron* v. *Manhattan Ry. Co.*, 132 U. S. 84, 90.

See also *Electric Cable Co.* v. *Edison Co.*, 292 U. S. 69; *Cash Register* v. *Cash Indicator Company*, 156 U. S. 502, 514; *Smith* v. *Hall*, 301 U. S. 216, 233.

In the case at bar it is not a question of a new result nor an old one performed more efficiently but of a mere combining of old devices each performing its old function and working out its own effect, without producing anything novel or new as a result of the combination, which is not patentable. *Adams* v. *Bellaire*, 141 U. S. 539; *Ide* v. *Ball Engine Co.*, 149 U. S. 550. This court should not be called upon again to pass upon the application of well-known principles of patent law.

Answering Petitioner's Argument Appearing as 4, on Page 16 of its Brief.

This court has frequently decided what a true combination is. In any event, as heretofore stated that was not the point involved in the case at bar as decided by the Circuit Court of Appeals.

It has been shown in this brief that the findings of the District Court were considered by the Appellate Court. It has also been shown that the Appellate Court did not reconstruct or reorganize a prior patent in the light of the teachings of the patent in suit.

CONCLUSION.

It is respectfully submitted that the questions presented by petitioner on page 3 of its petition and brief are in fact no questions at all and are not of such nature which should be considered by this court. The Circuit Court of Appeals in its opinion dealt with the pertinent Findings of Fact of the District Court and decided them to be "clearly erroneous". The Appellate Court did not reconstruct a prior patent in the light of the teachings of the patent in suit, but defeated the patent in suit on sound principles of patent law applied to the teachings of the prior art. No new result was produced; nor did the combination of old elements co-act together to produce the old result of the prior art in a more "facile, economical and efficient manner".

The petition is a captious one, apparently being made for purposes of delay so that the grant of the patent in suit may be continued as long as possible. No reason has been shown to warrant the exercise of this court's supervisory powers, and the petition should be denied.

New York, N. Y., May 12, 1941.

Respectfully submitted,

ROBERT I. DENNISON,
for Respondent.

PERCY FREEMAN,
MAXWELL E. SPARROW,
Counsel.